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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,781	10/19/2005	Ekaterina Vladimirovna Barsova	U 015759-8	6930

140 7590 04/23/2008

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EXAMINER	
BERTOGLIO, VALARIE E	
ART UNIT	PAPER NUMBER
1632	
MAIL DATE	DELIVERY MODE
04/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/533,781	BARSOVA ET AL.	
	Examiner	Art Unit	
	Valarie Bertoglio	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-26* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8,12-13,17-18 drawn to a nucleic acid encoding ppGFP1 (SEQ ID NO:2) and a cell, in vitro, comprising said nucleic acid.

Group II, claim(s) 1-8,12-13, 1-8,12-13,17-18, drawn to a nucleic acid encoding ppGFP2 including those encoding variants as set forth in SEQ ID NO:4,18,20,22,24,26 and 28 and a cell, in vitro, comprising said nucleic acid.

Group III, claim(s) 11-8,12-13,17-18, drawn to drawn to a nucleic acid encoding laesGFP (SEQ ID NO:6) and a cell, in vitro, comprising said nucleic acid.

Group IV, claim(s) 1-8,12-13,17-18, drawn to a nucleic acid encoding pmeaGFP1 (SEQ ID NO:8) and a cell, in vitro, comprising said nucleic acid.

Group V, claim(s) 1-8,12-13,17-18, drawn to a nucleic acid encoding pmeaGFP2 (SEQ ID NO:10) and a cell, in vitro, comprising said nucleic acid.

Group VI, claim(s) 1-8,12-13,17-18, drawn to a nucleic acid encoding pmedGFP1 (SEQ ID NO:12) and a cell, in vitro, comprising said nucleic acid.

Group VII, claim(s)1-8,12-13,17-18, drawn to drawn to a nucleic acid encoding pmedGFP2 (SEQ ID NO:14) and a cell, in vitro, comprising said nucleic acid.

Group VIII, claim(s) 1-8,12-13, 1-8,12-13,17-18, drawn to drawn to a nucleic acid encoding pdae1GFP (SEQ ID NO:16) and a cell, in vitro, comprising said nucleic acid.

Group IX, claim(s) 9, drawn to transgenic plant comprising a nucleic acid encoding ppGFP1 (SEQ ID NO:2) and a cell, in vitro, comprising said nucleic acid.

Group X, claim(s) 9, drawn to transgenic plant comprising a nucleic acid encoding ppGFP2 including those encoding variants as set forth in SEQ ID NO:4,18,20,22,24,26 and 28 and a cell, in vitro, comprising said nucleic acid.

Group XI, claim(s) 9, drawn to drawn to transgenic plant comprising a nucleic acid encoding laesGFP (SEQ ID NO:6) and a cell, in vitro, comprising said nucleic acid.

Group XII, claim(s) 9, drawn to transgenic plant comprising a nucleic acid encoding pmeaGFP1 (SEQ ID NO:8) and a cell, in vitro, comprising said nucleic acid.

Group XIII, claim(s) 9, drawn to transgenic plant comprising a nucleic acid encoding pmeaGFP2 (SEQ ID NO:10) and a cell, in vitro, comprising said nucleic acid.

Group XIV, claim(s) 9, drawn to drawn to transgenic plant comprising a nucleic acid encoding pmedGFP1 (SEQ ID NO:12) and a cell, in vitro, comprising said nucleic acid.

Group XV, claim(s) 9, drawn to transgenic plant comprising a nucleic acid encoding pmedGFP2 (SEQ ID NO:14) and a cell, in vitro, comprising said nucleic acid.

Group XVI, claim(s) 9, drawn to transgenic plant comprising a nucleic acid encoding pdae1GFP (SEQ ID NO:16) and a cell, in vitro, comprising said nucleic acid.

Group XVII, claim(s) 10, drawn to transgenic animal comprising a nucleic acid encoding ppGFP1 (SEQ ID NO:2) and a cell, in vitro, comprising said nucleic acid.

Group XVIII, claim(s) 10, drawn to transgenic animal comprising a nucleic acid encoding ppGFP2 including those encoding variants as set forth in SEQ ID NO:4,18,20,22,24,26 and 28 and a cell, in vitro, comprising said nucleic acid.

Group XIX, claim(s) 10, drawn to transgenic animal comprising a nucleic acid encoding laesGFP (SEQ ID NO:6) and a cell, in vitro, comprising said nucleic acid.

Group XX, claim(s) 10, drawn to drawn to transgenic animal comprising a nucleic acid encoding pmeaGFP1 (SEQ ID NO:8) and a cell, in vitro, comprising said nucleic acid.

Group XXI, claim(s) 10, drawn to transgenic animal comprising a nucleic acid encoding pmeaGFP2 (SEQ ID NO:10) and a cell, in vitro, comprising said nucleic acid.

Group XXII, claim(s) 10, drawn to transgenic animal comprising a nucleic acid encoding pmedGFP1 (SEQ ID NO:12) and a cell, in vitro, comprising said nucleic acid.

Group XXIII, claim(s) 10, drawn to transgenic animal comprising a nucleic acid encoding pmedGFP2 (SEQ ID NO:14) and a cell, in vitro, comprising said nucleic acid.

Group XXIV, claim(s) 10, drawn to transgenic animal comprising a nucleic acid encoding pdae1GFP (SEQ ID NO:16) and a cell, in vitro, comprising said nucleic acid.

Group XXV, claim(s) 11,14-15,19-22,24-26 drawn to a method of making ppGFP1 and the protein (SEQ ID NO:1), and method of using the protein as a label and detecting the protein.

Group XXVI, claim(s) 11,14-15,19-22,24-26 drawn to a method of making ppGFP2 and the protein (SEQ ID NO: 3,17,19,21,23,25 and 27) and method of using the protein as a label and detecting the protein.

Group XXVII, claim(s) 11,14-15, 19-22,24-26 drawn to a method of making laesGFP and the protein (SEQ ID NO: 5) and method of using the protein as a label and detecting the protein.

Group XXVIII, claim(s) 11,14-15, 19-22,24-26 drawn to a method of making pmeaGFP1 and the protein (SEQ ID NO: 7) and method of using the protein as a label and detecting the protein.

Group XXIX, claim(s) 11,14-15, 19-22,24-26 drawn to a method of making pmeaGFP2 and the protein (SEQ ID NO: 9) and method of using the protein as a label and detecting the protein.

Group XXX, claim(s) 11,14-15,19-22,24-26 drawn to a method of making pmedGFP1 and the protein (SEQ ID NO: 11) and method of using the protein as a label and detecting the protein.

Group XXXI, claim(s) 11,14-15, 19-22,24-26 drawn to a method of making pmedGFP2 and the protein (SEQ ID NO: 13) and method of using the protein as a label and detecting the protein.

Group XXXII, claim(s) 11,14-15,19-22,24-26 drawn to a method of making pdae1GFP and the protein (SEQ ID NO: 15) and method of using the protein as a label and detecting the protein.

Group XXXIII, claim(s) 16 drawn to an antibody to ppGFP1 and the protein (SEQ ID NO:1).

Group XXXIV, claim(s) 16 drawn to an antibody to ppGFP2 and the protein (SEQ ID NO:3,17,19,21,23,25 and 27).

Group XXXV, claim(s) 16 drawn to an antibody to laesGFP and the protein (SEQ ID NO: 5).

Group XXXVI, claim(s) 16 drawn to an antibody to pmeaGFP1 and the protein (SEQ ID NO: 7).

Group XXXVII, claim(s) 16 drawn to an antibody to pmeaGFP2 and the protein (SEQ ID NO: 9).

Group XXXVIII, claim(s) 16 drawn to an antibody to pmedGFP1 and the protein (SEQ ID NO: 11).

Group XXXIX, claim(s) 16 drawn to an antibody to pmedGFP2 and the protein (SEQ ID NO: 13).

Group XL, claim(s) 16 drawn to an antibody to pdae1GFP and the protein (SEQ ID NO: 15).

Group XLI, claim(s) 23 drawn to a method of analyzing a biomolecule comprising expression of a nucleic acid encoding ppGFP1.

Group XLII, claim(s) 23 drawn to a method of analyzing a biomolecule comprising expression of a nucleic acid encoding ppGFP2.

Group XLIII, claim(s) 23 drawn to a method of analyzing a biomolecule comprising expression of a nucleic acid encoding laesGFP.

Group XLIV, claim(s) 23 drawn to a method of analyzing a biomolecule comprising expression of a nucleic acid encoding pmeaGFP1.

Group XLV, claim(s) 23 drawn to a method of analyzing a biomolecule comprising expression of a nucleic acid encoding pmeaGFP2.

Group XLVI, claim(s) 23 drawn to a method of analyzing a biomolecule comprising expression of a nucleic acid encoding pmedGFP1.

Group XLVII, claim(s) 23 drawn to a method of analyzing a biomolecule comprising expression of a nucleic acid encoding pmedGFP2.

Group XLVIII, claim(s) 23 drawn to a method of analyzing a biomolecule comprising expression of a nucleic acid encoding pdac1GFP.

The inventions listed as Groups I-XLVIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The inventions listed as Groups I-XLVIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Unity of invention between different categories of inventions will only be found to exist if the specific combinations of inventions are present. Those combinations include:

1) A product and a special process of manufacture of said product.

2) A product and a process of use of said product.

3) A product, a special process of manufacture of said product, and a process of use of said product.

4) A process and an apparatus specially designed to carry out said process.

5) A product, a special process of manufacture of said product, and an apparatus specially designed to carry out said process.

The allowed combinations do not include multiple products, multiple methods of using said products, and methods of making multiple products as claimed in the instant application, see MPEP §

1850. The above set forth groups are drawn to multiple products, including nucleic acids, proteins, antibodies, plants and animals. Some groups include additional methods of using products.

Furthermore, PCT Rule 13.2 requires that unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. Applicant's claims encompass multiple inventions and do not have a special technical feature which link the inventions one to the other, and lack unity of invention. The only technical feature linking the inventions is a nucleic acid encoding a green fluorescent protein or the protein itself, which is not a contribution over the prior art (see Godwin, 1998, PNAS, Vol.95, pages 13042-13047). There is no special technical feature common to each group because the special technical feature of each group resides in its own sequence.

MPEP 1893.03(d) states: If an examiner (1) determines that the claims lack unity of invention and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable (i.e., meet the requirements of 35 U.S.C. 101, 102, 103 and 112), the nonelected invention(s) should be considered for rejoinder. Any nonelected product claim that requires all the limitations of an allowable product claim, and any nonelected process claim that requires all the limitations of an allowable process claim, should be rejoined. See MPEP § 821.04 and § 821.04(a). Any nonelected processes of making and/or using an allowable product should be considered for rejoinder following the practice set forth in MPEP § 821.04(b).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named

inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is (571) 272-0725. The examiner can normally be reached on Mon-Thurs 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Valarie Bertoglio, Ph.D./
Primary Examiner
Art Unit 1632